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10/037,325	01/03/2002	Harry W. Eberle III	0247-5	5841
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ERNEST D. BUFF ERNEST D. BUFF AND ASSOCIATES, LLC. 231 SOMERVILLE ROAD BEDMINSTER, NJ 07921				
EXAMINER				
GARCIA, ERNESTO				
ART UNIT		PAPER NUMBER		
3679				
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10/22/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/037,325

Applicant(s)

EBERLE, HARRY W.

Examiner

ERNESTO GARCIA

Art Unit

3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 June 2009 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Drawings

The drawings were received on June 8, 2009. These drawings are accepted. However, the amendment to claim 33 introduces a new drawings objection since it appears that one of the claimed features is not shown in the drawings.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the anchoring device being anchored by a metal fastener driven therethrough (claim 33, line 38) must be shown or the feature canceled from the claim. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet,

and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

Claim 33 is objected to because of the following informalities:

regarding claim 33, two commas have been placed together in line 3 and one should be deleted and --of said top element-- should be inserted after "sides" in line 11. Appropriate correction is required. For purposes of examining the instant invention, the examiner has assumed these corrections have been made.

Claim Rejections - 35 USC § 112

Claims 33-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 33, the recitation "said decking boards are situated atop said support board" in line 35 is redundant since lines 5-6 has set forth the same limitation.

Claim Rejections - 35 USC § 102

Claims 29, 31, and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Great Britain patent, GB-1,350,754 to Child.

Regarding claim 29, the British patent discloses, in Figure 10, an anchoring device consisting essentially of a substantially flat horizontal top element **A10** (see marked-up attachment provided in the Office action dated December 29, 2004), at least one substantially vertical support member **A20**, and a substantially flat horizontal bottom element **A30**. The top element **A10** has a top view configuration including two sides **A2** and a predetermined first width **A3** as measured side to side. The first width **A3** is measured at a maximum width between the sides **A2**. The top element **A10** has an imaginary center line **A4**. The support member **A20** is attached to an underside **A6** of the top element **A10** along the center line **A4** and the support member **A20** extends downwardly therefrom. The support member **A20** has two sides **A7** and a predetermined second width **A8** as measured side to side at a maximum width. The bottom element **A30** has a flat bottom view configuration, which includes sides **A31**, and having a generally trapezoidal shape, and a predetermined third width **A11** as

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measured side to side at a maximum width at a trapezoidal base **B1**. The first width **A3** is greater than the second width **A8** and the third width **A11**. The third width **A11** is greater than the second width **A8**. The device is made of molded plastic material (column 4, lines 72-84).

Applicant is reminded that the anchoring device can be adapted to maintain the top element in a predetermined position during use for joinder of two adjacent boards which have been pre-cut with receiving slots, and to position the bottom element upon a support board which two adjacent boards rest for attachment of the anchoring device to the support board for anchoring and support of the two adjacent boards.

Further, for the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising". See, e.g., PPG, 156 F.3d at 1355, 48 USPQ2d at 1355. See MPEP 2111.03.

Regarding claim 31, the two sides **A2** of the top element **A10** are symmetric relative to one another.

Regarding claim 32, the two sides **A2** of the top element **A10** are parallel to one another.

Claim Rejections - 35 USC § 103

Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Child, GB-1,350,754, in view of Curtis, Jr. 4,154,172.

Regarding claim 30, Child, as discussed fails to disclose the vertical support member having recesses with support columns located therebetween. Curtis, Jr. teaches in Figure 2 and 4, a support column **17', 21** having a recess to allow the insertion of a fastener therethrough (col. 2, lines 30-33, and col. 2, line 68, to column 3, line 4). Therefore, as taught by Curtis, Jr., it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a recess on the vertical support member to allow the insertion of a fastener in each recess. Further, it should be noted that one skilled in the art would have placed more than one recess to fasten the device at more than one location. Given the modification, support columns would have been inherently located between the recesses.

Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher et al., 5,704,181, in view of Aschheim, 6,012,256.

Regarding claim 29, Fisher et al. disclose, in Figure 3, an anchoring device comprising a substantially flat horizontal top element **14b**, at least one substantially

vertical support member **14c**, and a substantially flat horizontal bottom element **14a**. The top element **14b** has a top view configuration including two sides **A2** (see marked-up attachment provided in the Office action dated December 29, 2004). and a predetermined first width **A3** as measured side to side. The first width **A3** is measured at a maximum width between the sides **A2**. The top element **14b** has an imaginary center line **A4**. The support member **14c** is attached to an underside **A6** of the top element **14b** along the center line **A4** and the support member **14c** extends downwardly therefrom. The support member **14c** has two sides **A7** and a predetermined second width **A8** as measured side to side at a maximum width. The bottom element **14a** has a flat bottom view configuration which includes sides **A10** and having a generally trapezoidal shape, and a predetermined third width **A11** as measured side to side at a maximum width at a trapezoidal base **B1**. The first width **A3** is greater than the second width **A8** and the third width **A11**. The third width **A11** is greater than the second width **A8**.

However, Fisher et al. fail to disclose the device made of molded plastic material. However, Fisher et al. suggest, at column 6, lines 2-13, that changes in material may be made and since the grout mixture would change depending upon the anchoring device, i.e., the beam, being used, one would be motivated to use a plastic anchoring device suitable with a grout mixture to be used with plastic for making a play house of plastic material. Furthermore, Aschheim teaches in column 1, lines 22-27, that anchoring device, i.e., the sustainer, can be made of plastic as an alternative material for

sustaining episodic loads. Therefore, as taught by Aschheim, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the anchoring device from molded plastic material for making a play house of plastic material. Given the modification, it would be obvious and known that plastic material is capable of having a metal fastener driven through.

Applicant is reminded that the anchoring device can be adapted to maintain the top element in a predetermined position during use for joinder of two adjacent boards which have been pre-cut with receiving slots, and to position the bottom element upon a support board which two adjacent boards rest for attachment of the anchoring device to the support board for anchoring and support of the two adjacent boards.

Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher et al., 5,704,181, in view of Aschheim, 6,012,256, as applied to claim 29, and further in view of Naccarato, 6,442,908.

Regarding claim 30, Fisher et al., as modified above, fail disclose the vertical support member **14c** having recesses with support columns located therebetween. Naccarato et al. teach, in Figs. 4 and 5, a vertical support member **14c** having recesses **15** to promote optimal flow of grout material through the support member (col. 5, lines 29-35). Therefore, as taught by Naccarato et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to include recesses in the

vertical support member to promote optimal flow of grout material through the support member. Applicant is reminded that columns will be inherently located between the recesses as shown in Figure 3 of Naccarato et al.

Claims 33 and 35-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edwards, GB-1,567,008, in view of Slocum, 5,182,891, and further in view of Ellinwood, 2,362,252, and Eberle, EP-863,317.

Regarding claim 33, Edwards discloses, in Figures 1 and 2, a decking system comprising decking boards **P1**, **P2**, a support board **T**, and an anchoring device **A1** (see marked-up attachment). Each of the decking boards **P1**, **P2** has a top **A2**, a bottom **A3**, two sides **A4** and two ends (in and out of the paper). At least one groove **A5** is located along one of the sides **A4**. The anchoring device **A1** consists essentially of a substantially flat horizontal top element **4**, at least one substantially vertical support member **2**, and a substantially flat horizontal bottom element **8**. The top element **4** has a top view configuration including two sides and a predetermined first width **A6** as measured side to side. The first width **A6** is measured at a maximum width between the sides of the top element **4**. The top element **4** has an imaginary center line **A7**. The support member **2** is attached to an underside of the top element **4** along the center line **A7** and the support member **2** extends downwardly therefrom. The support member **2** has two sides and a predetermined second width **A8** as measured side to side at a maximum width. The bottom element **8** has a flat bottom view configuration,

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which includes sides, and having a generally trapezoidal shape, and a predetermined third width **A9** as measured side to side at a maximum width at a trapezoidal base **A10**. The first width **A6** is greater than the second width **A8**. The third width **A9** is greater than the second width **A8**. The decking boards **P1**, **P2** are situated atop the support board. The horizontal top element **4** is received in the grooves **A5** of the decking boards **P1**, **P2**. The bottom element **8** rests upon the support board **T**. The anchoring device **A1** joins and supports the decking boards on the support board **T**.

However, Edwards fails to disclose the first width **A6** being greater than the third width **A9**. The anchoring device being made of molded plastic material and being anchored by a metal fastener driven therethrough to the support board.

Edwards rather teaches the anchoring device made of metal. Applicant is reminded that, within the general skill of a worker in the art, selecting a known material on the basis of its suitability for the intended use is a matter of obvious design choice. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the anchoring device of plastic material since the material is readably available and it is known from Slocum to make anchoring devices from plastic (see cross-hatching in Figure 3, which shows plastic in an anchoring device 6). *In re Leshin*, 125 USPQ 416.

Ellinwood teaches, in Figure 4, an anchoring device being anchored by a metal fastener driven therethrough to a support board to fix the anchoring device to the support board. Therefore, as taught by Ellinwood, it would have been obvious to one of ordinary skill in the art at the time the invention was made to anchor the anchoring device of Edwards using a metal fastener drive therethrough to fix the anchoring device to the support board T of Edwards so as to prevent the anchoring device from moving.

Further, Eberle teaches, in Figure 10, an anchoring device having a first width being greater than a third width to be toe-nailed or screwed to support board (col. 5, lines 28-31). Therefore, as taught by Eberle, it would have been obvious to one of ordinary skill in the art at the time the invention was made to change the sizes of the anchoring device taught in Edwards so that the first width is greater than the third width to toe-nail or screw the anchoring device to the support board thus preventing the anchoring device from moving.

Further, for the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising". See, e.g., PPG, 156 F.3d at 1355, 48 USPQ2d at 1355. See MPEP 2111.03.

Regarding claim 35, given the modification, the two sides **A2** of the top element **A1** would have been symmetric to one another.

Regarding claim 36, given the modification the groove **A5** would have established an upper half of each of the decking boards **P1**, **P2** above the groove and a lower half of each of the boards below the groove. The upper half would have had a greater width than the lower half (note that the groove is not exactly at the center).

Regarding claim 37, given the modification the boards **A20** would have been made of material selected from the group consisting of synthetic polymers, at least partially foamed synthetic polymers, wood, wood composite, and combinations thereof.

Regarding claim 38, Edwards, as modified, fails to disclose the two sides of the top element **4** being parallel to one another. Ellinwood teaches, in Figure 4, the sides of the top element being parallel to one another so that the top element conforms to the bottom of the grooves in each of the docking boards. Therefore, as taught by Ellinwood, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the sides of the top element of Edwards parallel to one another in order to conform to the bottom of the grooves in each of the docking boards.

Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Edwards, GB-1,567,008, in view of Slocum, 5,182,891, Ellinwood, 2,362,252, and

Eberle, EP-863,317, as applied to claims 33 and 35-38, and further in view of Curtis, Jr. 4,154,172.

Regarding claim 34, Edwards, as modified, fails to disclose the vertical support member having recesses with support columns located therebetween. Curtis, Jr. teaches in Figure 2 and 4, a support column 17', 21 having recesses (the openings) to allow the insertion of a fastener therethrough (col. 2, lines 30-33, and col. 2, line 68, to column 3, line 4) and connect the anchoring device to anchoring boards. Therefore, as taught by Curtis, Jr., it would have been obvious to one of ordinary skill in the art at the time the invention was made to include recesses on the vertical support member to allow the insertion of a fastener thus connecting the anchoring device to the anchoring boards of Edwards. Given the modification, support columns would have been located between the recesses in general.

Response to Arguments

Applicant's reiterated arguments filed June 8, 2009 have been fully considered but they are not persuasive. Applicant has presented many of the same arguments for claims 29-32 as found in the appeal brief dated December 31, 2007, and in the response dated July 23, 2008 and these arguments have already been addressed by the examiner in the last two previous Office action and in the action dated April 2, 2008 (incorporated by reference thereto).

The new recitation "for joining two adjacent decking boards having pre-cut receiving slots and a support board" in lines 1-3 does not add any structure to the anchoring device and does not server to distinguish over the structural features of the prior art. Further, the anchoring device of the prior art is "configured" as claimed.

With respect to Chen et al. in view of Livezey, Jr., the arguments are moot in view of new grounds of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Peynichou, FR-1,217,468, teach an anchoring device without a vertical support member (Fig. 5). Bois, FR-1,556,252, teaches a flat horizontal bottom element having a trapezoidal shape (Fig. 4). Dickinson, 186,463, teaches an anchoring device that is anchored with a nail and made of wood.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. The new recitation "further wherein said decking boards are situated atop said support board ...and supports said decking boards on said support board" in claim 33, line 35-40, necessitated the new grounds of rejection. Accordingly, **THIS**

ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernesto Garcia whose telephone number is 571-272-7083. The examiner can normally be reached from 9:30AM-6:00PM. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached at 571-272-7087.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/E. G./

Examiner, Art Unit 3679

October 21, 2009

/Daniel P. Stodola/
Supervisory Patent Examiner, Art Unit 3679